

## **REMARKS/ARGUMENTS**

Applicant has carefully reviewed and considered the Final Office Action mailed on March 12, 2007, and the references cited therewith.

Claims 10-11 and 20-21 were previously canceled, no claims are amended or added; as a result, claims 1-9, 12-19, and 22- 24 are pending in this application.

### **§ 102 Rejection of the Claims**

Claims 1-4, 6, 13, 14, 16, 17 and 23 were rejected under 35 USC § 102(e) as being anticipated by U.S. Publ. No. 2004/0167619 to Case et al. (hereinafter "Case"). Applicant respectfully traverses the rejection as follows.

Applicant does not admit that Case is indeed prior art and reserves the right to swear behind the same at a later date. Nonetheless Applicant believes that the present application can be distinguished from Case for at least the following reasons.

Applicant respectfully submits that Case does not teach all elements and limitations in independent claims 1, 13, and 23. For example, Case does not teach, besides other things, a medical device having a generally tubular structure formed of material substantially invisible under magnetic resonance imaging visualization, as provided in claims 1, 13, and 23.

The Office Action states, "Case et al. disclose a device (Figure 15) comprising a generally tubular structure (80) formed of a material substantially invisible under MRI visualization (paragraph 38), . . . " (Page 2). However, in paragraph 38, Case states,

the present invention is exemplified by an intraluminal prosthesis, . . . , that further comprises elements or structure that allows a clinician, using selected means of external guidance, such as fluoroscopy, X-ray, ultrasound, M.R.I., etc., to readily identify the plane in which the prosthesis, or a particular portion thereof, lies prior to deployment within the patient and/or immediately thereafter.

([Paragraph 0038]). Case then defines the prosthesis as including a general structure that would not ordinarily include imageable features related to its primary

function that would otherwise allow reliable identification of its orientation under external imaging without the incorporation of the supplemental imageable structure or elements of the present invention that correspond to a functional characteristic of the device. ([Paragraph 0038]). From this, it appears that Case teaches a prosthesis that is specifically designed to be seen under methods such as fluoroscopy, x-ray, ultrasound, M.R.I., etc, and not a material substantially invisible under MRI visualization as provided in claims 1, 13, and 23.

In addition, Case states,

It is acknowledged that most prosthetic devices include a frame or structure that is at least somewhat visible under at least one external imaging method, such as fluoroscopy, ultrasonography, etc. However, only a subset of these prosthetic devices includes a structural adaptation for enhancing the ability of the device to be placed using external imaging, and typically such structural elements are limited to those, such as radiopaque markers at one or more ends of the device for facilitating placement at a target location, and do not correspond with a structural adaptation of the device for performing any particular function.

([Paragraph 0038]). Thus, it appears that Case further teaches a method of implanting a medical device that is at least somewhat visible under an external imaging method in a certain orientation by including additional visible markers highlighting a feature of the device. However, Case does not appear to teach a medical device, or stent, formed of a material substantially invisible under MRI visualization, as in claims 1, 13, and 23.

In addition, Applicant's specification describes the benefit of using a material substantially invisible under MRI visualization when it states,

MRI visualization is being explored as a visualization technique to be used when implanting devices such as stents. However, if the stent is made of material with a relatively high magnetic susceptibility, the stent distorts the MRI visualization in an area closely proximate the stent in the anatomy in which it is being implanted.

(Page 1, lines 24-29; Page 2, line 1). Thus, Applicant specifically describes the deficiencies of using medical devices using materials that are visible under an external imaging method in that such devices can distort, for example, the MRI visualization in an area closely proximate the medical device in the anatomy. The medical device taught by Case, on the other hand, does not appear to place any emphasis on the material forming the medical device at all and emphasizes instead placing the medical device in a certain orientation in the anatomy while recognizing that most devices are at least somewhat visible under an external imaging method.

Based on the forgoing, Applicant respectfully submits that Case does not support a proper 102(e) rejection of claims 1, 13, and 23. Applicant respectfully requests reconsideration and withdrawal of the 102(e) rejection for independent claims 1, 13, and 23, as well as those claims which depend therefrom.

*§ 103 Rejection of the Claims*

Claims 5 and 15 were rejected under 35 USC § 103(a) as being unpatentable over Case et al. in view of Tiefenbrun et al. (U.S. Patent No. 5,425,765). Applicant respectfully traverses the rejection as follows.

Claims 5 and 15 depend from independent claims 1 and 13, which are in condition for allowance for at least the reasons stated above. That is, Case does not teach each and every element contained in Applicant's independent claims 1 and 13. The Tiefenbrun reference does not cure the deficiencies of Case. For example, the Tiefenbrun reference does not describe, teach, or suggest, independently or in combination, a medical device having a generally tubular structure formed of material substantially invisible under magnetic resonance imaging visualization, as provided in claims 1 and 13.

As such, Applicant respectfully submits that each and every element and limitation of independent claims 1 and 13 are not taught or suggested by the Tiefenbrun reference and Case, either individual or in combination. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 103(a) rejection of dependent claims 5 and 15.

Claims 7-9 and 18-19 were rejected under 35 USC § 103(a) as being unpatentable over Case et al. (U.S. Publ. No. 2004/0167619). Applicant respectfully traverses the rejection as follows.

Claims 7-9 and 18-19 depend from independent claims 1 and 13, which are in condition for allowance for at least the reasons stated above. That is, Case does not teach each and every element contained in Applicant's independent claims 1 and 13. Specifically, Case does not teach a structure formed of material substantially invisible under magnetic resonance imaging (MRI) visualization, as provided in claims 1 and 13.

As such, Applicant respectfully submits that each and every element and limitation of independent claims 1 and 13 are not taught or suggested by Case. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the 103(a) rejection of dependent claims 7-9 and 18-19.

Claims 12, 22 and 24 were rejected under 35 USC § 103(a) as being unpatentable over Case et al. (U.S. Publ. No. 2004/0167619) in view of Jackson et al. (U.S. Publ. No. 2003/0004563). Applicant respectfully traverses the rejection as follows.

Claims 12, 22, and 24 depend from independent claims 1, 13, and 23, which are in condition for allowance for at least the reasons stated above. That is, Case does not teach each and every element contained in Applicant's independent claims 1, 13, and 23. The Jackson reference does not cure the deficiencies of Case. For example, the Jackson reference does not describe, teach, or suggest, independently or in combination, a medical device having a generally tubular structure formed of material substantially invisible under magnetic resonance imaging visualization, as provided in claims 1, 13, and 23.

As such, Applicant respectfully submits that each and every element and limitation of independent claims 1, 13, and 23 are not taught or suggested by the Jackson reference and Case, either individual or in combination. Accordingly,

Applicant respectfully requests reconsideration and withdrawal of the 103(a) rejection of dependent claims 12, 22, and 24.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (612) 236-0122 to facilitate prosecution of this matter.

**CERTIFICATE UNDER 37 CFR §1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS RCE Commissioner for Patents, P.O. BOX 1450 Alexandria, VA 22313-1450, on this 10<sup>th</sup> day of May, 2007.

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